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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,203	10/02/2000	Cornelius Borst	P-3875.09	3753

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MEDTRONIC, INC.  
710 MEDTRONIC PARK  
MINNEAPOLIS, MN 55432-9924

EXAMINER
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NASSER, ROBERT L

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/678,203

Applicant(s)

BORST ET AL.

Examiner

Robert L. Nasser Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Before beginning, the examiner notes that the requirement to establish common ownership for the purposes of 103c were somewhat misstated in the previous office action. It is not sufficient that the patent and the current application are commonly owned now. Applicant is required to establish that the **AT THE TIME OF INVENTION**, the patent and the current application were commonly owned or subject to an obligation to be assigned to a common owner. If applicant makes such a statement on the record, the rejection based on Boone will be withdrawn.

Claims 1-22, 32-48, and 51-56, and 63-68 do not find support in the parent applications, and therefore only have a priority date of 10/2/2000. Applicant pointed to figure 25 of the parent application to provide support, but figure 25 does not have a spreader on a distal end of an arm and an actuator on a proximal end, as claims in the claims enumerated above.

Claims 23-31 and 57-62 find support in all of the parent applications, except for 08/531363, which is now US Patent 5836311. As such, claims 23-31 and 57-62 have an effective filing date of 9/20/1995.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 8-18, 22, 32-35, 37, 39-50, and 63-68 rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al 5749892 in view of Boone et al 6464269.

The examiner notes Boone et al only qualifies as art under 35 USC 102(e). As such, based on the provisions of 35 USC 103c, if applicant were to affirmatively state on the record that that Boone et al and the current application were commonly assigned or subject to an assignment to the same party AT THE TIME OF INVENTION, then the rejection based on Boone would be withdrawn.

Vierra et al shows a device having an arm 43, , a spreader 51 connected to one of the arm and to the actuator. There are two contact members 15 and 17 connected to the spreader, which engage heart tissue via friction. The contact members can be actuated from an open to a closed position via an actuator at the other end of the arm (see columns 7, lines 44-48). The actuator actuates the arms to only have 2 positions, opened and closed. However, Boone et al shows a similar device where the arms are spread incrementally by rotating a wheel 5. As such, it would have been obvious to modify Vierra to have such an actuator, as it allows the physician to position the arms at the proper position for each patient. As such, the arms would have multiple positions. In addition, the first position is completely closed and the second and third positions are obtained by incremental rotations of the wheel. As such, the members 15 and 17 are substantially parallel in the first and second and third positions. The actuator knob is controlled by the clinician. With respect to claim 3, when inserted into the body, the members 15 and 17 are in the configuration shown in figure 3A. Hence, when they move, they move apart in a substantially parallel method. With respect to claim 11, the

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first position is spaced apart by less than 15 mm. The arm is fixable to a trocar or to an operating table (see column 12, lines 34-50). With respect to claim 18, since the coupling surface is friction, Vierra anticipates claim 18, as it need not show the suction features. Claim 22 is rejected for the reasons given above. Claims 50 and 53 are rejected in that the inner surface of members 15 and 17 is capable of engaging tissue. Hence, it is adapted to engage tissue. The examiner notes that adapted to contact tissue is an intended use limitation and the inner surface of the members 15 and 17 are capable of the intended use. Claims 51 and 54 are rejected in that there is a suction lumen open to the atmosphere through ports 73 in the contact surface. Claims 52 and 55 are rejected in that the contact surface is adapted to couple the members to the tissue. With respect to claims 32-35, 37, 39-50, and 63-68, Boone shows a stabilizer for a similar purpose where the feet 1 are parallel. Since the devices in Boone and Vierra perform substantially the same function, they are functional equivalents. As such, it would have been obvious to modify Vierra to use parallel feet rather than V shaped feet, as it is merely the substitution of on known configuration for another

Claims 1-4, 6, 8-18, 22, and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al 5749892 in view of Zhu et al 5293863. Vierra et al shows a device having an arm 43, , a spreader 51 connected to one of the arm and to the actuator. There are two contact members 15 and 17 connected to the spreader, which engage heart tissue via friction. The contact members can be actuated from an open to a closed position via an actuator at the other end of the arm (see columns 7, lines 44-48). The actuator actuates the arms to only have 2 positions, opened and closed.

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However, Zhu et al shows a retractor with 2 blades that are spread apart incrementally moving a handle 254. Such an arrangement allows a physician to position the arms at the proper location for each patient, as opposed to a one size fits all approach, As such, it would have been obvious to modify Vierra to have such an actuator, as it allows the physician to position the arms at the proper position for each patient. As such, the arms would have multiple positions. In addition, the first position is completely closed and the second and third positions are obtained by incremental rotations of the wheel. As such, the members 15 and 17 are substantially parallel in the first and second and third positions. The actuator knob is controlled by the clinician. With respect to claim 3, when inserted into the body, the members 15 and 17 are in the configuration shown in figure 3A. Hence, when they move, they move apart in a substantially parallel method. With respect to claim 11, the first position is spaced apart by less than 15 mm. The arm is fixable to a trocar or to an operating table (see column 12, lines 34-50). With respect to claim 18, since the coupling surface is friction, Vierra anticipates claim 18, as it need not show the suction features. Claim 22 is rejected for the reasons given above. Claims 50 and 53 are rejected in that the inner surface of members 15 and 17 is capable of engaging tissue. Hence, it is adapted to engage tissue. The examiner notes that adapted to contact tissue is an intended use limitation and the inner surface of the members 15 and 17 are capable of the intended use. Claims 51 and 54 are rejected in that there is a suction lumen open to the atmosphere through ports 73 in the contact surface. Claims 52 and 55 are rejected in that the contact surface is adapted to couple the members to the tissue.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Zhu et al, as applied to claims 1-4, 6, 8-18, 22, and 50-56, further in view of Furnish 5,498,256. Furnish shows a hand lever actuator for forceps. Hence, it would have been obvious to modify Vierra to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

Claims 5, 27, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Boone et al, as applied to claims 1-4, 6, 8-18, 22, 32-35, 37, 39-50, and 63-68, further in view of Furnish 5,498,256. Furnish shows a hand lever actuator for forceps. Hence, it would have been obvious to modify Vierra to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

Claim 7 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Boone et al, as applied to claims 1-4, 6, 8-18, 22, and 50-56, further in view of Garrison et al 5613937. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify Vierra to use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Claims 7, 29, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Boone et al, as applied to claims 1-4, 6, 8-18, 22, 32-35, 37, 39-50, and 63-68, further in view of Garrison et al 5613937. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify Vierra to

use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Boone et al, as applied to 1-4, 6, 8-18, 22, 32-35, 37, 39-50, and 63-68 above, further in view of Hossain et al 6063021. Hossain et al shows an identical device to Vierra that has a variable joint 40 controllable by knob 42. Such a joint allows better conformance of the device to the heart. Hence, it would have been obvious to modify Vierra et al to use such a joint, to allow a better fit onto the surface of the heart.

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Zhu et al, as applied to 1-4, 6, 8-18, 22, and 50-56 above, further in view of Hossain et al 6063021. Hossain et al shows an identical device to Vierra that has a variable joint 40 controllable by knob 42. Such a joint allows better conformance of the device to the heart. Hence, it would have been obvious to modify Vierra et al to use such a joint, to allow a better fit onto the surface of the heart.

Claims 23-26, 28, 30-35, 37, 39-50, and 57-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al 5749892 in view of Zhu et al 5293863 further in view of Goldstein 4635636. With respect to claims 32-35, 37, 39-50, and 63-68, Goldstein shows a stabilizer for a similar purpose where the feet are parallel. Since the devices in Goldstein and Vierra perform substantially the same function, they are functional equivalents. As such, it would have been obvious to modify Vierra to use parallel feet rather than V shaped feet, as it is merely the substitution of on known configuration for another



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Claims 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Zhu et al and Goldstein, as applied to claims 23-26, 28, 30-35, 37, 39-50, and 57-68, further in view of Furnish 5,498,256. Furnish shows a hand lever actuator for forceps. Hence, it would have been obvious to modify Vierra to use the actuator of Furnish, as it is merely the substitution of one known equivalent actuator for another.

Claims 29 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vierra et al in view of Zhu et al and Goldstein, as applied to claims 23-26, 28, 30-35, 37, 39-50, and 57-68, further in view of Garrison et al 5613937. In column 15, lines 40-60, Garrison teaches the equivalence of the rotating knob actuator of Vierra and the slide actuator recited in the claims. Hence, it would have been obvious to modify Vierra to use the actuator of Garrison, as it is merely the substitution of one known equivalent actuator for another.

Applicant's arguments filed 7/25/2005 have been fully considered but they are deemed moot in view of the new grounds of rejection.

Applicant had one argument that is still relevant. Applicant argued that the ports 73 of Vierra were not on a surface suitable for engaging tissue. The examiner disagrees, noting that the interior surface of the arms 15 and 17 is capable of grasping tissue.

Applicant's arguments filed 2/6/2006 have been fully considered but they are not persuasive.

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Applicant's response to the rejections based on Boone has been addressed at the beginning of this action.

Applicant has reiterated that the holes of Vierra are not "for engaging tissue" because they are for aspirating fluids from the delivery site. The examiner reiterates that the limitation in question is an intended use limitation and the manner of using a device will not distinguish over identical structure. Here, the ports of Vierra are suction ports and are capable of grasping tissue. Hence, the inner surfaces of the feet are capable of grasping tissue. As such, they meet the claim language. See In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

Applicant has asserted that the feet of Vierra move relative to each other at an angle and therefore are not disclosed as moving in a substantially parallel position from an open to a closed position. This appears to be a crux of applicant's arguments. It is the examiner's position that "substantially" parallel does not mean parallel and that applicant has not given a limiting definition of the term substantially. Therefore, it is the examiner's position it is within the broadest reasonable interpretation to conclude that the feet of Vierra move in a "substantially" parallel relationship.

Applicant has asserted that Zhu never discloses 2 blades moving relative to each other in a substantially parallel relationship. Avoiding the issue of the scope of the term substantially, it is the examiner's position that Zhu need not disclose the members moving relative to each other in a substantially parallel relationship to be useable. Indeed, the Federal Circuit has established that a reference is good for all it teaches. Here, Zhu is merely cited to teach an incremental actuator, i.e. one the incrementally

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moves the members apart. Such an actuator allows tailoring of the device for each individual, i.e. it accounts for different sized patients by allowing the feet to be set apart at different widths for different patients.

Applicant has asserted that the Vierra or Zhu references do not provide any motivation for the combination. It is the examiner's position that the Federal Circuit has clearly established that the motivation need not come from the references themselves, but may come from general knowledge in the art as well. It is the examiner's position that there is ample motivation on the record for the combination.

Applicant has further asserted that there is no teaching or motivation of moving the feet into a first second and third position. However, the examiner notes that the claims only require a device capable of being moved into first, second, and third positions. It is the examiner's position that when incrementally moved apart, the feel of the combination have multiple positions, each of which is substantially parallel to the previous position.

Applicant has asserted that the rejection based on Vierra, Zhu and Furnish is improper because there motivation for the combination. It is the examiner's position that substituting one art recognized equivalent for another has been established to be sufficient motivation by the Federal Circuit. See MPEP 2144.06

With respect to Hossain, applicant has stated that Hossain teaches away from two parallel members. The examiner notes that the claims only require substantially parallel members.

Applicant has further asserted that there is no motivation for the combination. It is the examiner's position that adequate motivation has been recited above.

With respect to applicant's comments concerning the Goldstein reference, again, it is the examiner's position that adequate motivation was provided above, again noting that the motivation need not come directly from the references. The combination would indeed have parallel members that were spread apart incrementally. Hence, there would be first, second, and third positions.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser Jr. whose telephone number is 571 272-4731. The examiner can normally be reached on 9:30 - 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RLN  
May 1, 2006

*Robert S. Marmor*  
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